

REMARKS

This amendment is in response to the Examiner's office action dated June 7, 2005.

1. Information Disclosure Statement

Applicants acknowledge the signed copy of the IDS from the Examiner.

2. Claim Objections

The Examiner objects to claims 3, 4 and 6 because of informalities. Applicant thanks Examiner for the suggested changes. The claims have been amended and Applicant respectfully requests reconsideration.

4. Claim Rejections – 35 U.S.C. § 112

The Examiner rejects claims 1-8 under the first and second paragraphs of 35 USC § 112. Claims 1 and 7 have been amended to include deposit information, and the specification has been amended on page 49 under the paragraph "DEPOSITS" to specify the deposit information for this variety. Applicants respectfully submit that these claims are now in form for allowance.

The Examiner rejects claims 6 and 8 under the second paragraph of 35 USC § 112, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. The Examiner rejects claim 6 because many of the members of the Markush group are not tissue types, but rather cell types or organ types and hence do not further define "tissue". Applicant respectfully traverses. The fact that members of the Markush group are cell types does not preclude them from further defining the term "tissue". The Merriam-Webster dictionary entry for tissue, attached as Appendix 1, defines tissue as "an aggregate of cells usually of a particular kind together with their intercellular substance that form one of the structural materials of a plant or an animal". Applicant asserts that the Markush group members further define tissue, and respectfully requests that this rejection be withdrawn.

The Examiner rejects claim 8 because "it is not clear if the soybean plant that is grown is a plant from the harvested seed or if it is some other soybean plant". Applicants respectfully traverse. Claim 8, which is a method claim, has been amended to be consistent with Examiner's recent suggested modification in other similar cases, and applicants respectfully submit that this claim is now in form for allowance.

4. Claim Rejections – 35 U.S.C. § 102/103

The Examiner rejects claims 1-8 as being anticipated by or obvious over Shannon (US Pat No. 6,049,029, hereinafter the '029 patent). Applicant respectfully traverses. Soybean variety XB64C04 has an elongated seed shape, as disclosed in Exhibit C of the PVP Certificate for XB64C04 (Attached as Appendix 2). In contrast, 95-04337 has a spherical-flattened seed shape as disclosed on page 5, line 46 of the '029 patent.

The Examiner states that "susceptibility" and "resistance" are relative terms and are not defined, so comparison to the soybean cyst nematode rating in the instant application could not be made. Applicant respectfully disagrees. 95-04337 is resistant to race 3 of soybean cyst nematode. ('029 patent, page 6, line 6). The term resistant is well known to those of ordinary skill in the art. In contrast, soybean variety XB64C04 has a rating of "5" on a scale of 1 to 9 for SCN race 3. Exhibit C of the PVP Certificate for XB64C04 discloses that this variety is susceptible to SCN race 3. Therefore, these two lines differ in their resistance to SCN race 3.

Also, XB64C04 demonstrates excellent resistance to frogeye leaf spot as disclosed on page 12 and 13 of the specification. The '029 patent is silent with regard to this trait and does not list frogeye leaf spot under the "Disease Reaction" section on pages 5-6. Applicant asserts that if resistance to frogeye leaf spot was present and was considered an important phenotypic characteristic of 95-04337, it would have been listed.

In addition, these two lines were derived from different parents. As disclosed in the PVP certificate for XB64C04, a copy of which is provided as Appendix 2, this line was derived from 9631/95B95. (Exhibit A of PVP Certificate No. 200500088). In contrast, 95-04337 was derived from different parents. As disclosed on page 5 of the

'029 patent, 95-04337 was derived from DP3682 and Hutchesonx(DP415xDPX2384 BC₁F₁). Therefore, XB64C04 is not identical to 95-04337.

The Examiner has stated that if the claimed plant and seeds of the instant invention are not identical to 95-04337, then it appears that 95-04337 only differs from the claimed plants and seeds due to minor morphological variation wherein said variation would not confer a patentable distinction to XB64C04 plants. Applicant respectfully traverses. The differences presented *supra* show that XB64C04 is not identical to 95-04337, and the Examiner has not provided any reference that may be combined with 95-04337 to arrive at the present invention. The Examiner has not provided a single reference with all elements of the claimed invention, nor a reference that could be combined with the '029 patent to produce XB64C04. Applicant respectfully asserts that a prima facie case of obviousness has not been made, and reconsideration is respectfully requested.

CONCLUSION

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested. If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

Please consider this a one month extension of time from September 7, 2005 to October 7, 2005, under the provision of 37 C.F.R. § 1.136(a) and charge Deposit Account No. 16-1852 for the amount of \$120.00. No other fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 16-1852.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



Steven Callistein
Reg. No. 43,525
Attorney for Applicant

Steven Callistein
Pioneer Hi-Bred International
7250 NW 62nd Avenue
P.O. Box 0552
Johnston, IA 50131-0552
(515) 254-2823